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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,133	09/10/2004	Tetsutaro Inoue	0020-5295PUS1	2676
2292	7590	09/26/2006		
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER BERNATZ, KEVIN M	
			ART UNIT	PAPER NUMBER

1773

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/507,133

Applicant(s)

INOUE ET AL.

Examiner

Kevin M. Bernatz

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

***Response to Amendment***

1. Amendments to the specification, filed on July 20, 2006, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 103***

3. Claims 1 and 3 – 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (U.S. Patent No. 6,284,361 B1) in view of Eichorst (U.S. Patent No. 5,726,001), Yamaguchi et al. (U.S. Patent No. 4,617,226) and Zinbo (U.S. Patent No. 6,312,796 B1) for the reasons of record as set forth in Paragraph No. 7 of the Office Action mailed on March 20, 2006.
4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. in view of Eichorst, Yamaguchi et al. and Zinbo as applied above, and further in view of Kolb et al. (U.S. Patent No. 6,733,906 B2) for the reasons of record as set forth in Paragraph No. 8 of the Office Action mailed on March 20, 2006.

***Response to Arguments***

**5. The rejection of claims 1 - 10 under 35 U.S.C § 103(a) – Kobayashi et al. in view of various references**

Applicant(s) argue(s) that “there would have been no motivation to combine the disclosure and teaching of Eichorst with that of Kobayashi et al.” since the technical field of Eichorst is different from that of the present invention (*pages 6 – 8 of response*). The Examiner respectfully disagrees.

The Examiner notes that this concern has already been addressed in the rejection of record (*last paragraph on page 4 of the office action mailed March 20, 2006*). Specifically, Eichorst explicitly refers to magnetic recording media in their disclosure (*col. 12, lines 36 – 39: “Surface-treatments of the magnetic particle can be used to aid in chemical stability or to improve dispersibility as is commonly practiced in conventional magnetic recording”*). As such, the Examiner deems there is sufficient evidence in the art that one of ordinary skill in the magnetic recording art, when seeking to solve a technical problem, would naturally turn to the related art of imaging elements utilizing transparent magnetic layers. As such, while the Examiner acknowledges that the Eichorst is directed to a different application, the Examiner deems that the Eichorst application *is* analogous to Kobayashi et al.’s application (which is the same as applicants).

Applicants further argue that neither Eichorst nor Kobayashi et al. teach how to suppress interfacial fluctuation at an interface between an upper magnetic layer and a lower non-magnetic layer. The Examiner agrees.

Applicant(s) are reminded that “the test for obviousness is not whether features of the secondary reference may be bodily incorporated into the primary reference’s structure, nor whether the claimed invention is expressly suggested in any one or all of the references, rather the test is what the combined teachings would have suggested to those of ordinary skill in the art.” *Ex parte Martin* 215 USPQ 543, 544 (PO BdPatApp 1981). In the instant case, the Examiner notes that the argued limitation is only in dependent claim 2. Kolb et al. discloses the subject matter as set forth in the rejection of record. Furthermore, applicants have presented no evidence towards unexpected results regarding the interface fluctuations.

Should applicants wish to put forth an argument of unexpected results, applicant(s) are reminded that **a detailed description of the reasons and evidence** supporting a position of unexpected results must be provided **by applicant(s)**. A mere pointing to data requiring the examiner to ferret out evidence of unexpected results **is not sufficient** to prove that the results would be truly unexpected to one of ordinary skill in the art. *In re D’Ancicco*, 439 F.2d 1244, 1248, 169 USPQ 303, 306 (1971) and *In re Merck & Co*, 800 F.2d 1091, 1099, 231 USPQ 375, 381 (Fed. Cir. 1986). In addition, applicants are reminded that the claims must be commensurate in scope with the showing of unexpected results.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

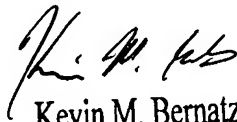
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (571) 272-1505. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KMB  
September 19, 2006

  
Kevin M. Bernatz, PhD  
Primary Examiner